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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR920020048US1 (15282)

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Signature _____

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Application Number

10/635,199

Filed

August 6, 2003

First Named Inventor

Michael J. Hind et al.

Art Unit

2193

Examiner

William H. Wood

Applicant requests review of the final rejection in the above-identified application.

An amendment canceling claims 5-14, and 18 is being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number _____.

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 42,976



Signature

Eunhee Park

Typed or printed name

516-742-4343

Telephone number

June 2, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required. see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 122. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael J. Hind et al. **Examiner:** William H. Wood
Serial No.: 10/635,199 **Art Unit:** 2193
Filed: August 6, 2003 **Docket:** YOR920020048US1 (15282)
Title: PROFILE NORMALIZATION IN AN AUTOMATIC SOFTWARE SYSTEM
Confirmation No.: 8332 **Dated:** June 2, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF CONFERENCE REQUEST

Sir:

In accordance with OG Notice of 12 July 2005, applicant requests a pre-appeal brief review for the reasons stated in the following remarks appearing on page 2 of this paper.

CERTIFICATION OF ELECTRONIC TRANSMISSION

I hereby certify that this paper is being electronically transmitted to the Patent and Trademark Office on the date shown below.

Dated: June 2, 2008


Eunhee Park

REMARKS

Claims 3-4 and 15-17 are pending in the present application. Claims 3-4 are independent and claims 15-17 are dependent claims.

Claim rejections under 35 U.S.C. §102(b)

Claim 3 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Arnold, M., “Online Profiling and Feedback-Directed Optimization of JAVA” (hereinafter “Arnold”). Applicants respectfully disagree. Arnold does not disclose or suggest, “A method for adjusting a profile collected for an executing application to account for one or more actions applied to the executing application to improve detection of phase shifts in the executing application after the profile was collected,” comprising at least, “detecting a phase shift in the executing application by utilizing the normalized profile and the second profile.” The Examiner in the Final Office Action dated January 25, 2008, cites Arnold’s page 72, line 24-page 73, line 6, as allegedly disclosing that element. The Examiner further states in his Advisory Action of May 1, 2008, “Arnold clearly profiles in multiple phases of collection.”

The Examiner errs in contending that Arnold’s phases of optimization read on the claimed “detecting a phase shift in the executing application.” As described in paragraph [0005] of the original specification, phase shift in an executing application refers to changes in behavior of the executing application that are inherent to the application. Thus, those inherent changes or phase shift can occur in the executing application even without having applied any other actions. Claim 3 recites, “utilizing the normalized profile and the second profile” to detect such inherent changes in the executing application’s behavior. Claim 3, thus, *inter alia*, determines whether the application’s change in behavior is due to an inherent application behavior change or a change induced by the “one or more actions.”

On the other hand, Arnold in the cited sections refers to a phase in an optimization process. As understood by applicants, Arnold's "phases" mean stages or steps. Arnold's "phase in an optimization process" refers to stages or steps of its optimization process. For instance, Arnold on page 72, lines 24 – page 73, line 6 describes that a "first phase" of its optimization process collects frequency count for all edges and basic blocks. Thus, while Arnold uses the terminology "phase," Arnold does so in a completely different context than is used in claim 3 and the present application. That is, Arnold's phase or step of optimization is not the same as the claimed "phase shift," which refers to changes in behavior of the executing application that are inherent to the application. Not only is Arnold silent on such inherent behavior of an executing application, but Arnold also nowhere discloses or suggests detecting such inherent changes using (e.g., comparing) a profile that is normalized and a profile that is collected after actually having applied the selected actions to an executing application.

For at least the above reasons, Arnold does not disclose or suggest at least, "detecting a phase shift in the executing application by utilizing the normalized profile and the second profile," claimed in claim 3.

Claim 4 similarly recites the "phase shift" element. Thus, the same foregoing reasons apply to claim 4. Claims 15-17 depend directly or indirectly from claim 3, therefore, by virtue of dependency, those dependent claims also are not anticipated by Arnold at least for those same reasons.

Respectfully submitted,



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